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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/806,123	05/18/2001	Ursula Ziegler	1998/G-026	7064
23416	7590	05/25/2004	EXAMINER	
CONNOLLY BOVE LODGE & HUTZ, LLP			JACKSON, MONIQUE R	
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WILMINGTON, DE 19899			ART UNIT	PAPER NUMBER
			1773	

DATE MAILED: 05/25/2004

Please find below and/or attached an Office communication concerning this application or proceeding.



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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Paper No. 05192004

Application Number: 09/806,123  
Filing Date: May 18, 2001  
Appellant(s): ZIEGLER ET AL.

Richard M. Beck  
For Appellants

**EXAMINER'S ANSWER**

**MAILED**

**MAY 25 2004**

This is in response to the appeal brief filed March 11, 2004.

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**(1) *Real Party in Interest***

A statement identifying the real party in interest is contained in the brief.

**(2) *Related Appeals and Interferences***

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

**(3) *Status of Claims***

The statement of the status of the claims contained in the brief is correct.

**(4) *Status of Amendments After Final***

No amendment after final has been filed.

**(5) *Summary of Invention***

The summary of invention contained in the brief is correct.

**(6) *Issues***

The appellants' statement of the issues in the brief is correct.

**(7) *Grouping of Claims***

The rejection of claims 1-12 stand or fall together because appellants' brief does not include a statement that this grouping of claims does not stand or fall together **and reasons in support thereof**. See 37 CFR 1.192(c)(7).

**(8) *Claims Appealed***

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(9) *Prior Art of Record***

DE 44 34 656

SIDLER

4-1996

**(10) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1-9 stand rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. This rejection is set forth in prior Office Action, Paper No. 13, dated 10/24/03.

Claims 1-9 stand rejected under 35 U.S.C. 103(a) as being unpatentable over EP 0 837 097 (EP'097). This rejection is set forth in prior Office Action, Paper No. 13, dated 10/24/03.

Claims 10-12 stand rejected under 35 U.S.C. 103(a) as being unpatentable over DE 4434656 (DE'656) in view of EP'097. This rejection is set forth in prior Office Action, Paper No. 13, dated 10/24/03.

**(11) Response to Argument**

A. With regards to the rejection of the term "high-molecular weight" the Appellants refer the Examiner to two EP documents incorporated by reference to provide guidance for the term "high-molecular weight" as being within the range of from 20,000 to 350,000, however the Examiner notes that neither these documents nor the instant disclosure suggest equating the term "high-molecular weight" to a value within this recited range. It is also noted that there is no clear indication whether the term refers to "high" **weight average** molecular weight, **number average** molecular weight, etc. Additionally, the Examiner notes that the incorporation of essential material in the specification by reference to a foreign application or patent, or to a publication is improper. Therefore, the Examiner maintains that given the disclosure at the time of the invention, one having ordinary skill in the art would not be reasonably apprised of the

scope of the claimed invention and could not interpret the metes and bounds of the claim so as to understand how to avoid infringement.

B. With respect to the obviousness rejection over EP'097, the Appellants first argue that EP'097 requires an additional "complicated" block copolymer to achieve the improved compatibility or adhesion that is not necessary for the instant invention, however it is noted that the instant invention is drafted in open transition language and hence does not exclude the incorporation of other materials. The Appellants also argue that EP'097 does not provide any examples utilizing polyacetals and that EP'097 does teach or suggest a composite article made from polyacetals and a specific SEBS compound. However, as discussed previously and noted by the Appellants on page 7 of their Remarks of Paper No. 12, filed 8/25/03, EP'097 does in fact suggest a composite article with the SEBS elastomer blend adhered to polyacetal, even though the Examiner notes that no specific example is provided. Therefore, given that EP'097 clearly suggests adhering the SEBS elastomer blend to polyacetal, and given the open transition claim language and an absence of a showing of unexpected results, the Examiner maintains her position that the instant invention would have been obvious to one skilled in the art at the time of the invention.

C. In terms of the rejection over DE'656, the Appellants appear to argue the references individually as opposed to in combination as presented in the rejection. In response to Appellants' arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). The Appellants first argue that the moldings of DE'656 include

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mechanical interlocks for bonding the two components and that nowhere does it mention a bond due to the elastomer composition, or the specific composition as recited. However, the Examiner again notes that the instant claims are drafted in open transition language and hence do not exclude an additional step of providing mechanical interlocks. DE'656 clearly teaches a method of producing a composite part including all the general process steps as instantly claimed wherein the part comprises a body made from a conventional plastic such as polyoxymethylene (a polyacetal) and a coating of injected, rubber-like material such as a styrene-olefin block copolymers like SBS or SEBS which have rigid end groups of styrene and flexible middle blocks of olefin, or other elastomer, or thermoplastic or polyurethane. Though DE'656 does not teach that the rubber-like coating comprises a mixture of the styrene-olefin block copolymer and a non-olefin thermoplastic as instantly claimed, it would have been obvious to one skilled in the art at the time of the invention to utilize a mixture of any of the suitable coating materials taught by DE'656 including the styrene-olefin copolymers, polyurethanes and thermoplastics, wherein EP'097 specifically teaches that a particular compatibilized mixture of these polymer materials provides improved adhesion of thermoplastic elastomers, such as styrene/ethylene/butene-block copolymers, to polar engineering resins such as polyacetals, wherein the mixture taught by EP'097 reads upon the instantly claimed mixture. Therefore, DE'656 provides a suggestion to one having ordinary skill in the art to utilize the particular materials of the instantly claimed mixture and EP'097 provides motivation for including the particular materials in the mixture in amounts as instantly claimed.

For the above reasons, it is believed that the rejections should be sustained.

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Respectfully submitted,



Monique R. Jackson  
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May 20, 2004

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